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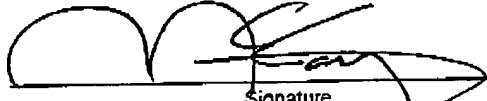
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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) STL11422	
I hereby certify that, on the date shown below, this correspondence is being facsimile transmitted to the Patent and Trademark Office, (571) 273-8300. 37 CFR §1.8(a) on <u>November 2, 2006</u> Signature <u>Diana C. Anderson</u> Typed or printed name <u>Diana C. Anderson</u>		Application Number 10/669,196	Filed September 23, 2003
		First Named Inventor Robert G. Bean	
		Art Unit 2113	Examiner Emerson Puente
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>38,794</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		 Signature <u>Mitchell K. McCarthy</u> Typed or printed name <u>(405) 232-0621</u> Telephone number <u>11/2/2006</u> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input type="checkbox"/> Total of <u>1</u> forms are submitted.			

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PATENT
Dkt. STL11422

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Robert G. Bean, Clark E. Lubbers and Randy L. Roberson**
Assignee: **SEAGATE TECHNOLOGY LLC**
Application No.: **10/669,196** Group No.: **2113**
Filed: **September 23, 2003** Examiner: **Emerson Puente**
For: **DATA RELIABILITY BIT STORAGE QUALIFIER AND LOGICAL UNIT METADATA**

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Alexandria, VA 22313-1450

APPLICANT'S REMARKS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

The Panel is now faced with the task of determining whether the Examiner has factually supported a *prima facie* cases of anticipation. Applicant prays that the Panel, upon an objective review of the facts set forth herein, will reach the conclusion that this case is not in condition for appeal. Rather, there are unresolved issues in this case that are not bona fide matters for appeal, but which must be resolved before this case is in condition for appeal.

CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10*

I hereby certify that, on the date shown below, this correspondence is being:

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Date: November 2, 2006


Signature

Diana C. Anderson
(type or print name of person certifying)

- 2 -

IT IS CLEAR ERROR THAT THE EXAMINER HAS NOT ESTABLISHED A *PRIMA FACIE* CASE OF ANTICIPATION OVER LUBBERS '643 BY FAILING TO SUBSTANTIATE EVIDENCE THAT IT IDENTICALLY DISCLOSES ALL THE RECITED FEATURES OF INDEPENDENT CLAIMS 1, 8 AND 15

Independent claims 1, 8, and 15 recite first information and first data that are stored with each other (or that accompany each other). Particularly, pertinent excerpts of these claims are as follows:

storing first information with first data....
(excerpt of claim 1, emphasis added)

accompanying first information with first data....
(excerpt of claim 8, emphasis added)

first information accompanying first data....
(excerpt of claim 15, emphasis added)

Applicant has established in the record without a rebuttal by the Examiner that Lubbers '643 discloses data being stored with respect to blocks of allocated storage space. (Applicant's Response of 10/2/2006 ppg. 7-9). However, the final rejection is based on Lubbers '643 disclosing the information and data being depicted in the same table. (Advisory Action of 10/24/2006)

Applicant has also established in the record without a rebuttal by the Examiner that the table of Lubbers '643 on which the Examiner relies is no more than a depiction of how data, both user data and parity data, is allocated among different blocks that are designated by logical block numbers (LBNs) across the domains in the array. Different allocated blocks are designated in the table for storing information about the data, such as the forced error (FE) bits stored in the FE block containing a bit for each LBN of the respective domain and indicating the reliability of the data stored in the LBNS.

Applicant has also established in the record without a rebuttal by the Examiner that by storing the information with (or accompanying) the data, as in the present embodiments as claimed, the associated processing overhead is significantly reduced in comparison to the extra I/Os required for the separate seeks for the information and the data in Lubbers '643. (see Applicant's Response of 10/2/2006, ppg. 7-9).

The Examiner's basis is clearly erroneous because data is stored to blocks, not to the table; the table is merely a depiction of how the blocks are allocated and how they

- 3 -

interrelate for purposes of data recovery. His basis is also clearly erroneous because the table itself expressly discloses that the information and the data are stored separately in different blocks. This clearly erroneous basis concludes with a clearly erroneous claim construction which is unreasonably broad because it ignores the plain meaning consistent with usage in the specification of the claim language. For example, the Examiner's claim construction unreasonably changes the plain meaning of *first information stored with first data* in claim 1 to "first information stored and first data," thereby effectively ignoring the explicitly recited claim term *with*. *In re Morris*, 43 USPQ2d 1753 (Fed. Cir. 1997). The same can be said for the Examiner's unreasonably broad construction of the term *accompanying*.

Before a closing of the merits, Applicant is entitled to an evidentiary showing that the cited reference identically discloses all the recited features of the rejected claims. Applicant has argued in the record that Lubbers '643 does not identically disclose the recited features of the rejected independent claims. The merits of that debate cannot rightfully end on the basis of a clearly erroneous claim construction which reads the *first information stored with first data* of claim 1, and the accompanying first information with first data of claim 8, and the *first information accompanying first data* of claim 15, onto the Lubbers '643 disclosure of the information and the data being stored separately. Even though in Lubbers '643 they are both depicted in the same table, the table itself expressly discloses that they are stored separately. Such errors do not form any bona fide basis for an appealable issue.

IT IS CLEAR ERROR THAT THE EXAMINER HAS NOT ESTABLISHED A *PRIMA FACIE* CASE OF ANTICIPATION OVER MORGAN '411 BY FAILING TO SUBSTANTIATE EVIDENCE THAT IT IDENTICALLY DISCLOSES ALL THE RECITED FEATURES OF INDEPENDENT CLAIMS 1, 8 AND 15

Independent claim 1 recites *first information directly indicates the status of the first data....* Applicant has established in the record without a rebuttal by the Examiner that Morgan '411 contrarily discloses code bits that do not directly indicate the status of data, but rather that retrospectively indicate which step in the process a fault occurred, requiring the execution of complex error correction routines and human intervention in the analysis

- 4 -

thereof.(see Applicant's Response of 10/2/2006, ppg. 13-15; Morgan '411 col. 6 lines 26-36).

Applicant has also established in the record without a rebuttal by the Examiner that the present embodiments as claimed employs information about the data that directly indicates the status of the data to the process, in order to prevent cascading errors that otherwise occur when the data presented to the process is unreliable. (see Applicant's Response of 10/2/2006, pg. 14).

Independent claims 8 and 15 recite *the first information indicates status of second data associated with the first data....* Applicant has established in the record without a rebuttal by the Examiner that Morgan '411 contrarily discloses code bits that are only associated with the data to which they are respectively appended. That is, in Morgan '411 there is a one-to-one correspondence of code bits to their respective data blocks; Morgan '411 is wholly silent regarding its code bits being associated with any other data blocks. (see Applicant's Response of 10/2/2006, ppg. 16-18)

The Examiner's claim construction is clearly erroneous in that it is unreasonably broad because it ignores the plain meaning consistent with usage in the specification of explicitly recited features of the rejected claims. For example, the Examiner's claim construction unreasonably changes the meaning of *directly indicates the status of the first data* to mean "indirectly indicates the status of a process step," thereby effectively ignoring explicitly recited claim language. *In re Morris* Also, the Examiner's claim construction unreasonably changes the meaning of *first information indicates the status of second data associated with the first data* to mean "first information indicates the status of the first data," thereby effectively ignoring explicitly recited claim language. *In re Morris*

Before a closing of the merits, Applicant is entitled to an evidentiary showing that the cited reference identically discloses all the recited features of the rejected claims. Applicant has argued in the record that Morgan '411 does not identically disclose the recited features of the rejected independent claims. The merits of that debate cannot rightfully end on the basis of the Examiner's clearly erroneous claim construction which reads the *first information directly indicates the status of the first data...* of claim 1 onto the Morgan '411 disclosure of code bits that indirectly indicate at which process step a fault occurred retrospectively, requiring complex error correction routines and human intervention in the analysis thereof. The merits of that debate also cannot rightfully end on

- 5 -

the basis of the Examiner's clearly erroneous claim construction that reads *first information indicates the status of second data associated with the first data* onto the Morgan '411 disclosure of code bits that are associated with only one block of data. Such errors do not form any bona fide basis for an appealable issue.

Conclusion

The Pre-Appeal Brief Panel must find in the underlying facts "substantial evidence" that adequately supports the Examiner's legal conclusion of anticipation. This approach is consonant with the Office's obligation to develop an evidentiary basis for its factual findings to allow for judicial review under the substantial evidence standard that is both deferential and meaningful. *see In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

For the reasons discussed above the examination resulting in maintaining the final rejection is incomplete with regard to the Examiner's obligation to consider the patentability of the invention as claimed. 37 CFR 1.104(a)(1). Also, because the final rejections are lacking a *prima facie* basis, the examination does not provide reasons for the rejections that are useful in aiding Applicant to judge the propriety of continuing the prosecution. 37 CFR 1.104(a)(2).

This case is not in condition for appeal due to the unresolved factual issue that the Examiner has not substantiated the anticipatory rejection by any evidence in the record whatsoever, and that the basis provided is clearly erroneous because it is based on an unreasonably broad construction of the recited claim language. This case is not ready for appeal until these factual issues are resolved by the Examiner either withdrawing the rejection or substantiating it factually in the record. Applicant prays the Panel will re-open the merits of this case for that purpose.

Respectfully submitted

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